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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,054	10/03/2000	Albrecht Dorschner	Beiersdorf 656-KGB	4744

7590

11/15/2002

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EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 11/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Acknowledgment is made of the amendment filed 8/1/02. Claims pending are 5-19.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. The rejection of Claims 10 and 11 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, is maintained for the reasons of the record.

As discussed in the previous Office Action, there is insufficient antecedent basis for the limitation "in the finished cosmetic or dermatological preparations" in the claims.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. The rejection of Claims 5-13 under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Neumiller is maintained for the reasons of the record. New Claims 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Neumiller.

With respect to new Claims 14 and 18, Thomas et al. teach ethoxylated glycerol-based non-ionic surfactants (col. 9, lines 30-65) and N-lower alkyl neoalkanamide insect repellents (col. 3, lines 44-61). With respect to new Claims 15-17, the claimed emulsifiers are well

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known in the emulsion art and are conventionally used for the same art-recognized purpose as the emulsifiers of Thomas et al.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use the claimed emulsifiers in emulsions of Thomas et al. for their art-recognized purpose and with a reasonable expectation of arriving at the emulsion having the same properties as the emulsions of Thomas et al.

5. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Neumiller and further in view of Stewart (US 6,159,452).

Thomas et al. in view of Neumiller applied as discussed in the previous Office Action.

Neither reference explicitly teaches ethyl 3-(N-acetyl-N-butylamino) propionate of the instant claims. However, Stewart teaches 3-[N-butyl-N-acetyl]-aminopropionic acid, ethyl ester can be used as an insect repellent "together with DEET, or instead of DEET". See col. 4, lines 50-59.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to substitute DEET of Thomas et al. with ethyl 3-(N-acetyl-N-butylamino) propionate of Stewart with a reasonable expectation of deriving the same insect repelling effect as set forth in the Thomas reference. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection.

Response to Arguments

6. Applicant's arguments filed 8/01/02 have been fully considered but they are not persuasive.

In response to the Applicant's argument that the emulsions of Neumiller are not microemulsions, it is noted that Neumiller was offered as a supplemental reference to show that it is conventional to use glycerin in cleaning compositions for improving stability of the dispersed phase in the continuous phase. Both, Thomas et al. and Neumiller are analogous art as they are directed to aerosol cleaning compositions. Therefore, it is the Examiner's opinion that it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use glycerin of Neumiller in cleaning compositions of Thomas et al. for its art-recognized purpose.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml

11/11/02

JOSE G. DEES
SUPERVISORY PATENT EXAMINER

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